

**REMARKS**

Applicant hereby responds to the Office Action of March 20, 2006. Before this reply, Claims 1-25 were pending in the above-referenced patent application. Through this reply, new Claims 26-33 have been added. As such, claims 1-33 are now pending in the patent application. New matter has not been added.

Claims 1-25 were rejected under 35 U.S.C. 102(a) as being anticipated by USPN 6,738,978 to Hendricks et al ("Hendricks") in view of USPN 6,898,762 to Ellis et al. ("Ellis"). Rejection of Claims 1-25 is respectfully traversed because, for at least the following reasons, the references, alone or in combination, do not disclose all of the claimed limitations.

A per **Claim 1**, Applicant respectfully disagrees with the Examiner's interpretation of Hendricks (Fig. 36a, Figs. 30b-g, 31, 32a-b) as teaching the limitations of selection means for allowing the end user to select between the at least one regular program, the at least one Background Commercial for display on the presentation unit, as required by Claim 1. Background Commercials according to the present invention differ from typical commercial advertisements. A typical commercial advertisement is shown between or in the middle of regular non-commercial programs. Hendricks, col. 38, lines 32-46, describes that during viewing a regular television program, the system switches the user to another channel to show the user commercial advertisements. The regular television program is interrupted for the commercial advertisements. Whereas, Background Commercials herein are available and viewable anytime, even when a

regular program is being displayed (i.e., the Background Commercials are carried in the background of the regular (non-commercial) programming). Therefore, as claimed, regular programming is not required to be interrupted to view Background Commercials, whereas in Hendricks, regular programming is required to be interrupted to view commercials/advertisements/movie purchase, etc.

Hendricks, Fig. 36a, Figs. 30b-g, 31, 32a-b, relied on by the Examiner, show service/program menus not Background Commercials. Hendricks has to interrupt regular programming to show commercials. Even is such service/program menus can be interpreted as Background Commercials (which Applicant traverses), the references, alone or in combination, fail to disclose all of the claimed limitations.

Further, Hendricks does not disclose selection means for allowing the end user to select, for display on the presentation unit, between: the at least one regular program, the at least one Background Commercial, and the at least one regular program with the at least one Background Commercial, as required by Claim 1. Hendricks does not disclose means for providing a digital signal, the digital signal having information reflective of at least one regular program and at least one Background Commercial. In the present invention, Background Commercials differ from typical commercial advertisements in Hendricks because a typical commercial advertisement in Hendricks is located between or in the middle of regular non-commercial programs. In col. 38, lines 32-46 (relied on by the Examiner), Hendricks states that during viewing a regular television program by a user, the system switches the user to another channel to show the user commercial

advertisements, whereby the regular television program is interrupted for the commercial advertisements. Whereas, Background Commercials herein can be available anytime, even when a regular program is displaying, i.e., the Background Commercials are carried in the background of the regular (non-commercial) programming. Hendricks does not disclose a digital signal having information reflective of at least one regular program and at least one Background Commercial as claimed. The commercial advertisements in Hendricks are not Background Commercials as claimed herein.

Further, Hendricks does not disclose selection means for allowing the end user to select, for display on the presentation unit, between: the at least one regular program, the at least one Background Commercial, and the at least one regular program with the at least one Background Commercial, as required by Claim 1. In Hendricks, the user cannot select the commercial advertisements that are shown to the user. The commercial advertisements are selected by the system based on the information gathered on the type of regular television program a user watches, and the system selected commercial advertisements are then sent to the set top terminal 220 (col. 32, lines 48-55; col. 36, lines 61-64; col. 37, lines 11-16). The system then interrupts the regular television programming and based on the type of regular television program being watched switches the user to a channel to show him the system selected commercial advertisements without selection by a user (col. 38, lines 32-46).

In Hendricks, the user is not provided with the opportunity to select between the regular television programs and commercial advertisements as claimed herein. Rather, in

Hendricks the system selected commercial advertisements are shown to the user by interrupting regular television programming at a frequency that is selected by the system, not the user (col. 37, lines 16-27). In Fig. 3 (relied on by the Examiner) the remote 900 or any other interface do not allow the user to select between a regular program and a Background Commercial for display on the presentation unit. By contrast, as required by Claim 1, selection means is provided for allowing the end user to select between the at least one regular program and the at least one Background Commercial for display on the presentation unit.

Further, unlike Hendricks, the return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator. In Hendricks the set top terminal 220 does not communicate commercial viewing data to the controller 214. Rather, in Hendricks regular television programming viewing data is sent back to the controller 214 by the terminal 220. This is further made clear by the fact that in Hendricks, as discussed above, the user cannot select the commercials that are shown to the user (the system selects the commercials). As such, there is no commercial viewing data gathered by the set top terminal 220 to be sent back to the controller 214 since the user cannot select commercials. In Hendricks regular television programming viewing data is sent back to the controller 214 by the terminal 220 because the user can select which regular television program to watch.

In the Office Action, the Examiner has interpreted commercial channels such as shopping channels, air line reservation, etc. in Hendricks as background commercial

channels that the user can select. This interpretation of Hendricks is respectfully traversed. The commercial channels in Hendricks are not background commercial advertisements as claimed herein. In Hendricks, the user selects the commercial channels to actively interact business whereas the commercial advertisements are promotional materials put together by advertisers and shown to the user by the system during a television program to entice the user to buy certain goods/services (e.g., advertisement entices the user to select a commercial channel to buy the advertised goods/services). Hendricks explicitly describes advertisements and how they are displayed to the user (discussed above and further in Hendricks, for example in col. 35 line 65 to col. 39, line 8). The Examiner's interpretation of commercial channels in Hendricks as advertisements goes against explicit teachings of Hendricks itself as to what an advertisement is. Indeed, in Hendricks the mechanism for selection and viewing of the commercial channels is much the same as that of regular television channels, further illustrating that commercial channels are not advertisements and certainly not Background Commercials as claimed herein.

Further, as the Office Action also states, Hendricks does not disclose displaying at least one regular program with at least one background commercial. This further corroborates Applicant's arguments above that Hendricks does not disclose the claimed selection means.

However, the Examiner interprets Ellis to disclose displaying at least one regular program with at least one background commercial, and then modifies Hendricks

according to Ellis to reject Claim 1. Applicant respectfully traverses this interpretation of Ellis, and further submits that no Prima Facie case of obviousness has been established, and that the references, alone or in combination, do not disclose all of the claimed limitations.

Figs. 18 and 20a of Ellis, along with col. 17, lines 37-53 and col. 20, lines 43-58, simply discuss showing a program guide on a TV screen over video for current channel. As with Hendricks, the program guide in Ellis is not a Background Commercial. Ellis has to interrupt regular programming to show commercials, regardless of how the program guide is displayed. Even is such program guide in Ellis can be interpreted as Background Commercials (which Applicant traverses), the references, alone or in combination, fail to disclose all of the claimed limitations.

The program guide is not Background Commercial information according to the present invention. Unlike program guide of Ellis, Background Commercials are commercial advertisement programs which require a user's permission, or, request in order for them to access the user's presentation unit. Conversely, if there is no permission or request from a user, then Background Commercials will not be presented at the user's presentation unit. Thus, unless the user desires to receive the Background Commercials, then the user will not be bothered by any Background Commercials while watching regular programs. Background Commercials, as defined herein, differ from typical commercial advertisements because a typical commercial advertisement is located

between or in the middle of regular non-commercial programs. Whereas, Background Commercials can be available anytime, even when a regular program is displaying, i.e., the Background Commercials are carried in the background of the regular non-commercial. Banner Information is information descriptive and/or related to the Background Commercials. Banner Information takes the form of text, graphics, and images, which are associated with the content of the Background Commercials. Alternatively, Audio-Visual Information of a Background Commercials is the audio and video contents of the Background Commercials similar to typical commercial within regular TV programs. Hence, Background Commercials can have Banner Information and/or Audio-Visual Information.

Further, as in Hendricks, Ellis does not disclose selection means for allowing the end user to select, for display on the presentation unit, between: the at least one regular program, the at least one Background Commercial, and the at least one regular program with the at least one Background Commercial.

Further, Hendricks is directed to a network controller for use with a digital cable headend capable of monitoring and controlling set top terminals in a television program delivery system. The network controller manages a configuration of set top terminals. The controller is used in program delivery systems with multiple channels of programming, a menu driven program selection system, and a program control information signal that carries data and identifies available program choices. The controller modifies a program control information signal at the cable headend before the

modified signal is transmitted to each set top terminal. This signal is used with polling methods to receive upstream data from the set top terminals. The controller initiates such upstream data retrieval, gathers all data received and compiles viewer demographics information and programs watched information. The controller processes this data and information to generate packages of advertisements, as well as account and billing reports, targeted towards each set top terminal. As such, there is no advantage in modifying Hendricks according to Ellis.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). Neither of the references suggests the motivation to modify or combine the references as proposed.

The references are individually complete and functionally independent for their limited specific purposes and there would be no reason to make the modification proposed by the Office Action. Because neither of the prior art references suggests the



combination and modifications proposed by the Office Action the combination and modifications are improper.

Further, according to Hendricks, col. 7, lines, 28-42, subscribers are able to access an expanded television program package and view selected programs through a menu-driven access scheme that allows each subscriber to select individual programs by sequencing a series of menus. The menus are sequenced by the subscriber using simple alpha-numeric and iconic character access or moving a cursor or highlight bar on the TV screen to access desired programs by simply pressing a single button, rather than recalling from memory and pressing the actual two or more digit numeric number assigned to a selection. Thus, with the press of a single button, the subscriber can advance from one menu to the next. In this fashion, the subscriber can sequence the menus and select a program from any given menu. The programs are grouped by category so that similar program offerings are found on the same menu. As such, there is no advantage in modifying Hendricks according to Ellis to show program guide overlays of Ellis.

Even if Hendricks is modified with Ellis as the Examiner suggests to show program menu overlays on regular programs, the commercials in Hendricks would still interrupt regular programming to be viewed. Hendricks, col. 38, lines 32-46, describes that during viewing a regular television program, the system switches the user to another channel to show the user commercial advertisements. The regular television program is interrupted for the commercial advertisements. This is shown in Fig. 36a, Figs. 30b-g,

31, 32a-b, relied on by the Examiner. For at least reasons, rejection of claim 1 and all claims dependent therefrom should be withdrawn.

**As per Claim 2**, Hendricks does not disclose that the information reflective of the at least one Background Commercial contains Audio-Visual Information and/or Banner Information, the Banner Information being presented to the presentation unit with the at least one regular program. Figs. 30c-30g in Hendricks (relied on by the Examiner) does not disclose commercial banner information that is displayed with a regular program as claimed herein. The only reference to a banner in Hendricks (col. 47, lines 31-33) is in relation to Fig. 31 in conjunction with a menu, not in conjunction with a regular television program that is in progress, as claimed herein. The banner in Hendricks shows date and time, not advertisements. The banner in Hendricks has no commercials, and is not shown along with a regular television program.

There is no disclosure in Hendricks that: “information reflective of the at least one Background Commercial contains Audio-Visual Information and/or Banner Information,” as claimed herein. There is no disclosure in Hendricks of: “the Banner Information being presented to the presentation unit with the at least one regular program,” as claimed herein.

**As per Claim 3**, Hendricks does not disclose a control switch whereby the user can filter the Background Commercial portion of the digital signal from being delivered to the presentation unit, as claimed. As discussed in relation to Claim 1, in Hendricks the

system (i.e., controller 214) selects advertisements or background commercials, not the user. Further, the user cannot filter background commercials selected by the controller 214. In col. 16, lines 16-61 (relied on by the Examiner), there is no disclosure that a user can filter advertisements as claimed. In Hendricks, commercial selection and display is done by the system (i.e., controller 214 and set top terminal 220, without ability of the user to filter commercials). Hendricks does not provide any ability for the user to select or filter commercials that the controller 214 selects and sends to the terminal 220. If the Examiner believes otherwise, Applicants respectfully request that the Examiner provide specific reference to language and software/hardware in Hendricks that receives filtering commands from the user, and allows commercial filtering by the user.

**As per Claim 4**, Hendricks does not disclose means for communicating the Background Commercial Viewing Data over the return channel from the receiver to the service operator, as claimed. The return channel in the claimed invention is configured to communicate Commercial Viewing Data from the receiver to a digital service operator. As discussed above, in Hendricks information about user viewing of regular programming is sent back from the set top terminal 220 to the controller 214. There is no Background Commercial Viewing data in Hendricks to send back to the controller 214. Further, Hendricks does not disclose means for updating a Background Commercial Viewing Record with the Background Commercial Viewing Data communicated from the receiver to the digital service operator, as claimed.

**As per Claims 5-10**, Applicant respectfully objects to the omnibus rejection of these claims without specific reasoning for rejection of each claim. Nevertheless, Applicant hereby attempts to respond to these rejections as best understood by Applicant. The Examiner has rejected Claims 5-10 for essentially the same reasons as rejection of Claims 1-4 and further in view of Fig. 12 with viewer log file, and col. 31, line 18 to col. 32, line 65 in Hendricks.

Rejection of Claims 5-10 is respectfully traversed for at least the reasons provided in relation to Claims 1-4 above. Further, Hendricks states that the viewer log file in Fig. 12 contains viewer information which as the Examiner admits the system in Hendricks uses to select and target advertisements to viewers (i.e., viewers do not select/filter advertisements). As discussed above, no Background Commercial Viewing Data is generated in Hendricks or sent to the controller 214. Nor is there a file or database in Hendricks which stores Background Commercial Viewing Data as such data does not exist and is not gathered in Hendricks. As detailed above, user viewing habits of watching regular programs are gathered by the monitor 220 and sent to the controller 214 which is used to target advertisements to the users. Further, as per claim 5, for at least the reasons discussed above in relation to claim 1, Hendricks and Ellis, alone or in combination do not disclose a receiver for receiving the digital signal and a presentation unit for displaying at least a portion of the digital signal, the Banner Information being presented to the presentation unit with the at least one regular program, as required by Claim 5.

**Claim 11** was rejected for essentially the same reasons as rejection of Claim 1, and as such should be allowed for at least the reasons provided above in relation to Claim 1. Further, as discussed in relation to Claim 2, Hendricks does not disclose a combined digital television signal which combines information reflective of regular programming and Background Commercials, the information reflective of the Background Commercials containing Audio-Visual Information and/or Banner Information, as claimed herein. Further, Hendricks does not disclose the steps of, in the receiver selecting a selected portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit, as claimed herein.

Further, Hendricks does not disclose creating a combined digital television signal which combines information reflective of regular programming and Background Commercials. Hendricks does not even disclose a digital signal that includes Background Commercials. Nor does Hendricks disclose that the information reflective of the Background Commercials containing Audio-Visual Information and/or Banner Information, as claimed. Further, Hendricks does not disclose selecting a selected portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit, as claimed. Further, as per claim 11, for at least the reasons discussed above in relation to claims 1 and 5, Hendricks and Ellis, alone or in combination do not disclose selecting a selected portion of the combined digital signal from the information reflective of the regular programming and the Background Commercials for display at a presentation unit;

and displaying the selected portion of the combined digital signal on the presentation unit, as required by Claim 11.

**Claims 12-14** were rejected for the same reasons as rejection of Claims 2-4, and should be allowed for at least the reasons provided above in relation to Claim 1 and Claims 2-4. Further as to Claim 13, Hendricks does not disclose the steps of determining an economic benefit based upon the updated Background Commercial Viewing Record. Nor does Hendricks disclose providing that economic benefit to the end user.

**Claim 15** was rejected for essentially the same reasons as rejection of Claim 1 and the additional interpretation by the Examiner that: in Fig. 3 the user uses a remote interface for controlling the TV and cable box or set top terminal 220 -- a receiver in receiving digital stream signals and decoding digital signals (Fig. 24c and col. 12, line 35 to col. 14, line 40 for the set top terminal and the remote control device).

Rejection of Claim 15 is respectfully traversed for at least the reasons provided above in relation to rejection of Claim 1. Further, as discussed in relation to Claim 2, Hendricks does not disclose a digital signal having information reflective of a regular program and at least one Background Commercial, wherein the information reflective of the at least one Background Commercial contains Banner Information, as claimed herein.

In Fig. 3 (relied on by the Examiner) the remote 900 does not provide a mechanism for selection between a regular program and a Background Commercial for

display on the presentation unit. Fig. 24c in Hendricks is a schematic of the set top terminal 220, and col. 12, line 35 to col. 14, line 40 in Hendricks (relied on by the Examiner) provides a description of the set top terminal 220 and the remote control device 900. In these passages Hendricks does not disclose means for receiving the signal reflective of the at least one Background Commercial and providing a signal reflective of the Banner Information. Hendricks does not disclose any Banner Information related to commercial information as claimed herein.

Clearly, there is no disclosure in Hendricks of the steps of a means for providing a video output signal that combines information from the signal reflective of the regular program and the signal reflective of the Banner Information. As noted, no Banner Information of the type claimed herein is disclosed by Hendricks. The Examiner refers to the lengthy passage in col. 12, line 35 to col. 14, line 40 in Hendricks, but fails to specifically point out clear language in that passage which discloses the claimed limitations. That passage says nothing more than what has already been addressed herein as far as the claimed limitations are concerned. If the claims are once again rejected, Applicant respectfully requests that the Examiner point to specific language in Hendricks that discloses the claimed limitations, rather than generally pointing to a lengthy section of Hendricks. Further, as per claim 15, for at least the reasons discussed above in relation to claims 1 and 5, Hendricks and Ellis, alone or in combination do not disclose for providing a video output signal, the means for providing the video output signal combining information from the signal reflective of the regular program and the signal reflective of the Banner Information, as required by Claim 15.

**Claims 16-17 and 18-25**, were rejected for essentially the same reasons as rejection of Claims 1-15, and are therefore allowable for at least the reasons provided in relation to Claims 1-15. Further, the Examiner has provided general conclusory remarks in rejecting the claims without specific references to Hendricks or Ellis. The Examiner's conclusions are not supported by Hendricks and Ellis for at least the following reasons.

As per Claim 16, Hendricks and/or Ellis does not disclose: "a User Interface means for obtaining User commands to enable or disable the inclusion of Banner Information in the video output signal and a control unit for providing control signals reflective of the User commands." As discussed above, in Hendricks and/or Ellis there is no commercial Banner Information as claimed herein and further the user cannot enable or disable inclusion of commercials, as claimed herein. The Examiner has not pointed to disclosure in Hendricks and/or where such limitations are disclosed.

Further, as per Claim 17, there is no mechanism in Hendricks and/or Ellis to gather or store Background Commercial viewing data, as claimed. There is no mechanism in Hendricks to provide a signal reflective of selected Background Commercial viewing data, as claimed herein. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further as per Claim 18, Hendricks and/or Ellis does not disclose that information reflective of the at least one Background Commercial contains Audio-Visual Information



and Banner Information, as claimed herein. Further, Hendricks does not disclose:

“means for receiving the second signal reflective of the at least one Background Commercial and providing *a first BC signal* reflective of the Banner Information related to one of the at least one Background Commercials and *a second BC signal* reflective of Audio-Visual Information related to the one of the at least one Background Commercials,” as required by Claim 18 (emphasis added). Nor does Hendricks and/or Ellis disclose: “means for providing a video output signal, the means for providing the video output signal combining information from one of (i) the signal reflective of the regular program or (ii) the second BC signal, with information from the signal reflective of the Banner Information,” as required by Claim 18. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 19, Hendricks and/or Ellis do not disclose that: “the means for receiving the signal reflective of the at least one Background Commercial provides a *third BC signal* reflective of information identifying the one of the at least one Background Commercials,” as required by Claim 19 (emphasis added). The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 20, Hendricks and/or Ellis do not disclose: “a selection means for allowing an end user to select between information from the signal reflective of the regular program and information from the second BC signal for inclusion in the video output signal,” as required by Claim 20. The remote device in Hendricks and/or

Ellis has nothing to do with selecting a BC signal, as claimed because as discussed advertisements in Hendricks and/or Ellis have nothing to do with displaying Background Commercials with regular programming as claimed. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 21, Hendricks and/or Ellis does not disclose: “a User Interface means for obtaining User commands to enable or disable the inclusion of Banner Information and/or the second BC signal in the video output signal and a control unit for providing control signals reflective of the User commands,” as required by Claim 21. Nor are there multiple BS signals disclosed by Hendricks and/or Ellis. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 22, Hendricks and/or Ellis does not disclose: “a storage means for storing Background Commercial view data and a transmission means for providing a return signal reflective of the Background Commercial view data,” as required by Claim 22. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 23, Hendricks and/or Ellis does not disclose: “a storage means for storing information from the second BC signal, and means for replaying the second BC signal stored in the storage means to the means for providing a video output signal for inclusion in the video output signal,” as required by Claim 23. The Examiner

has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 24, Hendricks and/or Ellis does not disclose: “a storage means for storing information from the second BC signal and means for replaying the second BC signal stored in the storage means to the means for providing a video output signal for inclusion in the video output signal, wherein there is information reflective of a plurality of Background Commercials within the digital signal, the second BC signal stored in the storage means is related to the plurality of the Background Commercials, and the means for replaying provides one or several of the stored plurality of Background Commercials for inclusion in the video output,” as required by Claim 24. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

Further, as per Claim 25, Hendricks and/or Ellis does not disclose: “a storage means for storing information from the signal reflective of the regular program, and means for replaying the signal reflective of the regular program stored in the storage means to the means for providing a video output signal for inclusion in the video output signal,” as required by Claim 25. The Examiner has not pointed to disclosure in Hendricks and/or Ellis where such limitations are disclosed.

New Claims

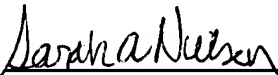
New claims 26-33 add further limitations disclosed in the specification originally filed and cover how banner information and/or audio-visual information in background commercials are displayed. For at least the aforementioned reasons, the references, alone or in combination, do not disclose the limitations of these new claims.

**CONCLUSION**

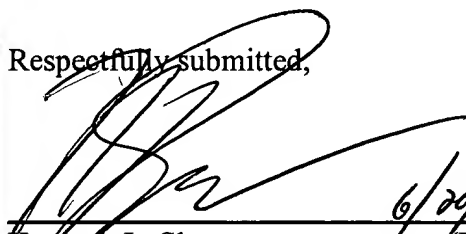
Please charge any deficit or credit any surplus to our Deposit Account No.

01-1960. A duplicate copy of this page is enclosed for this purpose.

For these, and other, reasons, Applicants believe that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested.

<b><u>CERTIFICATE OF MAILING</u></b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June <u>20</u> , 2006.	
By Sarah A. Nielsen	
	_____ Signature
<u>June 20, 2006</u>	

Respectfully submitted,

  
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